REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 27, 33 and 39 have been cancelled. Claims 1, 9, 17, 43, 44 and 45 have been amended. Antecedent basis for the amendments is located throughout Applicant's specification, as for example in connection with the discussion of Figs. 3L and 3N on pages 16-17. Accordingly, no new matter has been added. Claims 1, 2, 5-10, 13-18, 21-26, 28-32, 34-38 and 40-51 are pending.

35 U.S.C. § 103(a)

In the Office Action mailed July 3, 2006, claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,096 ("Kuppusamy") in view of U.S. Patent No. 6,697,997 ("Fujimura").

Claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;
> at a first location within the electronic version, detecting a reference to a second location that is exclusive of the first location, wherein the detected reference at the first location is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference at the first location, embedding a hyperlink within the detected reference at the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device instead of the first location on the display device.

MPEP § 2142 states, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the

shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to claim 1, Kuppusamy and Fujimura are defective in establishing a prima facie conclusion of obviousness. For example, as between Kuppusamy, Fujimura and Applicant's specification, only Applicant's specification teaches the entire combination of all elements in claim 1. In fact, Kuppusamy and Fujimura teach away from such combination.

Claim 1 requires, "***embedding a hyperlink*** within the detected reference ***at the first location***, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device ***instead of the first location*** on the display device." By comparison, if Kuppusamy's link is triggered in the TOC document 220, the focus of the target document 202 is transferred to an anchor in the target document 202, so that the target document 202 scrolls ***in the right frame 219*** until the heading corresponding to the entry comes into view (see col. 9, lines 43-55). But the TOC document 220 (which includes such link) continues being displayed, even if such link is triggered in the TOC document 220. Consequently, ***Kuppusamy teaches 180° away*** from the limitation in claim 1 of "embedding a hyperlink within the detected reference at the first location, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device instead of the first location on the display device."

Moreover, the Office Action acknowledges that Kuppusamy "***fails*** to explicitly state that the embedded hyperlink is found within the detected reference." Yet, the Office Action states, "however, the reference detected was suggested as within the ***same display*** as the table of contents so therefore was used to provide a detected reference, as presently claimed."

Apparently, the Office Action is trying to read the "***first location***" of claim 1 as being Kuppusamy's "***same display,***" which includes both: (a) the target document 202, which contains the ***detected reference***; and (b) the table of contents ("TOC") document 220, which contains the ***embedded hyperlink***. Nevertheless, claim 1 also requires that the ***detected reference is to a second location that is exclusive of the first location***. Accordingly, if the Office Action tries to read Kuppusamy's detected reference (which is located in the target document 202) as being to a second location ***within*** Kuppusamy's "same display," then Kuppusamy's second location is: (a)

not exclusive of the "same display"; and (b) therefore, ***not*** exclusive of the first location, which the Office Action is reading as the "same display" (including both the target document 202 and the TOC document 220). Consequently, based on the Office Action's explanation, ***Kuppusamy teaches 180° away*** from the limitation in claim 1 that "the detected reference is to a second location that is exclusive of the first location."

In fact, the Office Action acknowledges that Kuppusamy fails to teach that the second location is exclusive of the first location. Nevertheless, the Office Action cites Fujimura as somehow providing a way of generating links to external documents, keeping track of locations within one document or multiple external documents for document analysis and history of changes. However, even if Fujimura is read in such a manner, it fails to change the fact that Kuppusamy: (a) clearly teaches 180° away from the limitation in claim 1 that "the detected reference is to a second location that is exclusive of the first location"; and (b) therefore, teaches away from any other combination that would meet such limitation. Moreover, even if Kuppusamy and Fujimura were somehow combined, the Office Action failed to clearly explain how such combination would teach the entire combination of all elements in claim 1.

Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of claim 1 is not supported. Likewise, a rejection of claims 9, 17, 43, 44 and 45 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9, 17, 43, 44 and 45.

Dependent claims 2, 5-8, 25, 26, 28-30, 46 and 47 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10, 13-16, 31, 32, 34-36, 48 and 49 depend from and further limit claim 9 and therefore are allowable.

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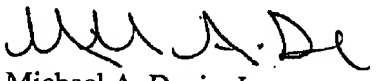
Dependent claims 18, 21-24, 37, 38, 40-42, 50 and 51 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 5-10, 13-18, 21-26, 28-32, 34-38 and 40-51 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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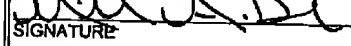

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